

REMARKS / ARGUMENTS

These remarks are made in response to the advisory action mailed September 23, 2004 responsive to the Applicants reply (August 5, 2004) to the office action mailed on May 4, 2004. An appropriate fee for a time extension has been included.

In the Advisory Action, the Examiner stated that the arguments and affidavits included within the reply of August 5, 2004 were not considered. For clarification as to the reasons, Applicants teleconferenced with the Examiner's supervisor (Examiner was out of the Office at the time), Fang Tsang on October 4, 2004. Mr. Tsang clarified that the reasons the arguments were not considered were procedural in nature and that Applicants' options to proceed included the filing of a petition, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE). Applicants respectfully follow Mr. Tsang's suggested approach of filing an RCE, which is the second filing of such a request in the instant application, in order to expedite prosecution and to minimize cost to the client.

Before continuing, a brief review of the case history to this stage may be helpful. In the reply of July 28, 2003 (first reply) to an office action (first office action), Applicants included an affidavit under 37 C.F.R. § 1.131 supporting the removal of Liversidge as a reference. The Examiner (in a second office action dated December 18, 2003) stated the presented affidavit and remarks were insufficient to show conception. The arguments and affidavits within the reply of August 5, 2004 attempted to traverse the rejection and provide the Examiner with additional support to show conception and diligence of the Applicants' invention. These remarks were not considered for procedural reasons, as noted in the advisory action of August 5, 2004 and as confirmed in the teleconference of October 4, 2004.

Consequently, claims 1-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0076025 to Liversidge, *et al.* (Liversidge). To overcome Liversidge, the Applicants have submitted affidavits under 37 C.F.R. § 1.131 and provided additional proof of conception and diligence (as detailed below) and supported by the accompanying affidavits (which are more comprehensive than those submitted with the first reply).

In response to the Office Action, Applicants have enclosed Declarations under 37 C.F.R.

§ 1.131 supporting the removal of Liversidge as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0053 (Disclosure) entitled "E-mail Client with 'Set-Up a Voice Conference' Feature" The Disclosure and Declarations demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as June 7, 2000, which predates the effective date of Liversidge (December 18, 2000).

The Disclosure represents the completion of an internal International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document utilized by IBM and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure once the Disclosure has been completed. Any changes and/or additions are appended as an attachment to the IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since June 7, 2000.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present application, including each claim within the present application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the USPTO, the inventors reviewed the application to insure that the claims and material contained therein are fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Liversidge until July 19, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application. Instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the application that is iteratively reviewed by each inventor until such time that the

U.S. Patent Appln. No. 09/910,271
Response dated October 5, 2004
Office Action dated May 5, 2004
Docket No. BOC9-2000-0060 (195)

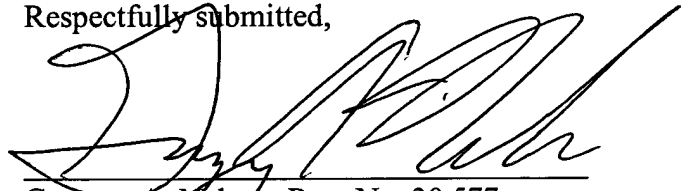
inventors are satisfied that the application sufficiently details the inventive concepts detailed in the disclosure, at which time the application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Liversidge and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed Declarations, Liversidge should be withdrawn as a reference for purposes of 35 U.S.C. § 102(e), which action is respectfully requested. Withdrawal of Liversidge as a reference results in a withdrawal of the rejections with respect to claims 1-37.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Dated: 10/5/04

Respectfully submitted,



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